

Remarks

Claims 5 through 14 are pending in this application. Claims 1 through 4 were previously cancelled by Preliminary Amendment. In view of the Response to Restriction Requirement filed June 12, 2008, Claim 14 has been withdrawn. Applicants have herein cancelled Claim 14. Nevertheless, Applicants reserve the right to pursue the subject matter of Claim 14 in a later application, if desired. The pending claims stand rejected under 35 U.S.C. §102(e) and 35 U.S.C. §103. This paper contains amendments under 37 C.F.R. §1.121. Support for the amendments to the claims can be found in the specification, for example, at page 34, lines 24 through 31.

Status of the Claims

Applicants respectfully acknowledge the Office's comments regarding the status of the claims.

Note

Applicants respectfully acknowledge the Office's note indicating that the elected species was not found and that the search was extended to a next species.

Priority

Applicants respectfully acknowledge the Office's comments regarding priority.

Rejection of Claims 5 through 9, 11, and 13 under 35 U.S.C. §102(e)

Claims 5 through 9, 11, and 13 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Sawyer *et al.* (WO 02/094833 with priority filing date of May 24, 2001) and Beight *et al.* (US Patent 7,087,626B2). While Applicants do not acquiesce to the merits of this rejection, in order to advance prosecution, Claim 5 has been amended to delete the heterocycle and optionally substituted heterocycle substituents provided for R2. In there place, specific heterocycles and substituted heterocycles as detailed on, at minimum, page 34, lines 24 through 31 of the specification are included for R2 in Claim 5. Applicants assert that this amendment overcomes the noted rejection for independent Claim 5 and dependent Claims 6 through 9, 11, and 13. Therefore, Applicants respectfully request withdrawal of this rejection.

Rejection of Claims 5 through 13 under 35 U.S.C. §103(a)

Claims 5 through 13 are rejected under 35 U.S.C. §103(a) as allegedly being obvious over Sawyer *et al.* (WO 02/094833 with priority filing date of May 24, 2001) and Beight *et al.* (US Patent 7,087,626B2). Applicants respectfully disagree with this rejection.

Enacted on November 29, 1999, the American Inventors Protection Act (AIPA) added subject matter which was prior art under former 35 U.S.C. §103 via 35 U.S.C. §102(e) as disqualified prior art against the claimed invention if that subject matter and the claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” See MPEP 706.02(l)(1)I. The Sawyer reference qualifies as prior art under 35 U.S.C. §102(e) for the present application. Both Sawyer *et al.* and the present application were, at the time the invention was made, subject to an obligation of assignment to Eli Lilly and Company. Thus, Sawyer *et al.* is disqualified prior art against the claimed invention, making the rejection under 35 U.S.C. §103(a) improper. Applicants note that Beight *et al.* is the national phase filing from Sawyer *et al.* and, as such, is also not prior art against the claimed invention. Applicants, therefore, respectfully request withdrawal of this rejection.

Conclusion

Applicants assert that the above-stated remarks overcome the Office’s rejections for this application. Applicants courteously solicit reconsideration of this rejection and passage of this case to issuance.

Respectfully submitted,

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